

REMARKS/ARGUMENTS

I. NON-PRIOR ART MATTERS

A. Election/Restrictions

In the Amendment and Response filed October 22, 2003, Applicant elected claims 1 and 2 without traverse.

B. Drawings

The cover sheet to the Office Action states that the drawings filed in October 1999 are objected to by the Examiner. However, on October 22, 2003, Applicant submitted an entire new set of drawings and a substitute specification.

Applicant requests the Examiner's assistance in locating the drawings and reviewing same.

C. The Office Action rejected claims 1-2 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejection.

The Office Action states that "the body of claim 1 is lacking any clearly defined data processing method for introducing an asset-backed fixed income security, and no tracking step."

Claims need only "reasonably apprise those skilled in the art" for their scope and be "as precise as the subject matter permits."¹ The test of definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.²

A claim need not describe the invention, such description being provided by the specification's disclosure section.³

The claim, in light of the specification, is not indefinite or incomplete.

¹ *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81 (Fed. Cir. 1986)

² *Id.*

³ *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986)

Furthermore, the "tracking step" which the Office Action alleges is missing comprises steps 1) through 4), all of which are involved with "tracking the flow of quantitative data."

The Office Action further states: "Regarding claim 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention."

Claim 2 has been amended and is now allowable.

- D. The Office Action rejected claims 1-2 under 35 USC 101 because the claimed invention is allegedly directed to non-statutory subject matter as applied in the prior office action.

The Office Action makes the following response to Applicant's arguments: "that the claimed invention is not in the technological arts as the claimed invention must utilize technology in a non-trivial manner." The Office Action cites *In re Musgrave* and *In re Johnston*, which are extremely old, CCPA cases, and completely ignores Applicant's arguments based on the latest Federal Circuit law. Applicant submits that the Federal Circuit decisions presented in the previous response are the controlling law.

The Office Action also cites *Ex parte Bowman*. The decision specifically states that it is not binding precedent on the board. In addition, the decision states:

"The Examination Guidelines for Computer-Related Inventions are not dispositive of this case because there is absolutely no indication on this record that the invention is connected to a computer in any manner." 61 USPQ2d 1669, 1671

In marked contrast, claim 1 claims "A data processing method for introducing an asset-backed fixed income security that will function as a master real currency unit with a constant value, comprising tracking by means of a digital computer, the flow of quantitative data generated by the steps of..." (emphasis supplied). Therefore the Examination Guidelines for Computer-Related Inventions should have been used in examination of this application, as previously argued.

Applicant respectfully requests reconsideration and allowance of the rejected claims.

II. PRIOR ART MATTERS.

- A. The Office Action rejected claims 1 and 2 under 35 USC 103(a) as being unpatentable over Hartnett as applied in the previous Office Action. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.⁴ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.⁵

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁶

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The Office has the burden of showing why the claims do not comply with 35 USC 103. Instead, the Examiner has merely stated that Applicant's arguments do not comply with 37 CFR 1.111(b) without specifically stating why. For example, the Office Action argues that Applicant may not show nonobviousness by attacking references individually when the rejections are based on combinations of references. But this rejection is not based on a combination of references!

Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*⁷ The MPEP requires the Examiner to do so.⁸ However, the Examiner has made no finding of the level of ordinary skill in the art.⁹

⁴MPEP Sec. 2142.

⁵ Id.

⁶Id. (emphasis supplied)

⁷ 383 U.S. 1 (1966)

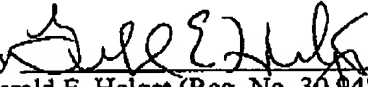
⁸ MPEP § 2141

⁹ MPEP § 2141.03

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

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